



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1456
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,655	03/16/2001	Areal Guerra Rogelio	G80-019 U/S	2667

21706 7590 07/07/2003
NOTARO AND MICHALOS
100 DUTCH HILL ROAD
SUITE 110
ORANGEBURG, NY 10962-2100

EXAMINER

ALVO, MARC S

ART UNIT PAPER NUMBER

1731

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/744.655	GUERRA	
	Examiner	Art Unit	
	Steve Alvo	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as obvious over CANADIAN PATENT

2,142,195.

CANADIAN PATENT 2,142,195 teaches deacidifying paper (cellulose-type material) by preparing a solution of carbonated alkoxymagnesium compounds (page 6, lines 1-8) and diluted with a hydro fluorocarbon. CANADIAN PATENT 2,142,195 teaches using several different homologs of alkoxymagnesium compounds, e.g. methyl magnesium methyl carbonate and ethoxymagnesium methyl carbonate and teaches that "other suitable carbonated magnesium alkoxides can be prepared by either of the above methods using other solvents to produce the corresponding homologs of methoxymagnesium methyl carbonate", see page 13-16. Thus it would have been obvious to use the homolog propanol to produce the homolog magnesium di-n-propylate. See page 6 for carbonated magnesium alkoxide in solvent of 5%. The exact amounts of components would have been obvious to the routineer. See CANADIAN PATENT 2,142,195, page 5, line 27-page 6, line 8. See CANADIAN PATENT 2,142,195, page 6, line 27 for 2% diluent and page 7, line 10 for 10% or less; see page 6, line 36 for the solvent, e.g. n-propanol of 5%; see page 6, line 27, for carbonated magnesium alkoxide of 2% in solution. The final composition ratios do not appear to differ from that of the CANADIAN PATENT as the CANADIAMN PATENT teaches the final components to be carbonated magnesium alkoxide, of 2% in solution; 5% solvent in the diluted solution, e.g. n-propanol and 2% diluent. The amount of carbonated magnesium alkoxide is a rate effective variable which would have been obvious to

adjust to provide the proper amount of deacidification depending amount the substrate to be deacidified and the amount of deacidification needed.

Claims 22, 23, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26 and 27 are drawn to composition and do not differ from the composition of claims 22 and 25 respectively. Claim 22 the term "in the n-propanol of the solution" is indefinite. The solution comprises carbonated magnesium di-n-propylate, n-propanol and diluent. Wouldn't all the components be in solution, e.g. does this differ from 30-70% W/V of the solution being carbonated magnesium di-n-propylate ? How does this differ from the concentration of claim 23?

The argument that the use of the homolog propanol in the CANADIAN PATENT causes unexpectedly destructive results is not convincing as Applicant has not presented any evidence to show this. Besides Applicant is using propanol in the instant process in a similar way as the alcohol is used in the CANADIAN PATENT. Why would the propanol be destructive in the composition of the CANADIAN PATENT when it is not destructive in the instant composition?

Applicant has argued that the instant composition requires less dehydration than normal deacidification compositions, but does not claim the moisture content as part of the composition. The CANADIAN PATENT teaches using moisture contents as high as 2%. This does not to appear to differ from the moisture content of the instant composition.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Application/Control Number:
09/744,655
Art Unit: 1731

Page 4

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

When filing an **“Official” FAX** in Group 1730, please indicate in the Header (upper right) **“Official”** for papers that are to be entered into the file. The **“Official” FAX** phone numbers for this TC 1700 are:

Non-Final Fax: (703) 872-9310

After-Final FAX: (703) 872-9311

When filing an **“Unofficial” FAX** in Group 1730, please indicate in the Header (upper right) **“Unofficial”** for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers. The **“Unofficial” FAX** phone number for this Art Unit (1731) is **(703) 305-7115**.

Any inquiry concerning this communication or earlier communications from the **primary examiner** should be directed to **Steve Alvo** whose telephone number is **(703) 308-2048**. The Examiner can normally be reached on Monday - Friday from **6:00 AM - 2:30 PM (EST)**.

Application/Control Number:
09/744.655
Art Unit: 1731

Page 5

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on 703-308-3837.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is **(703) 308-0661**.

MSA
7/3/2003

A handwritten signature in black ink, appearing to read 'S Alvo', is positioned above the printed name and title.

STEVE ALVO
PRIMARY EXAMINER
ART UNIT 1731